

REMARKS

The claims have been amended to clarify the invention. Claim 8 has been amended to recite dependence from claim 7. Claim 9 has been amended to recite specific polynucleotide SEQ ID NOs: disclosed in the specification (at Table 4) as full length genes encoding full length proteins. Claim 9 has been further amended to recite a naturally occurring variant of these polynucleotide sequences having at least 90% sequence identity to the recited polynucleotide sequences. Support for this amendment is found in the specification, for example, at p. 9, lines 13-19; and at p. 12, lines 25-34. Claim 17 has been amended to recite dependence from claim 12. No new matter is added by this amendment, and entry of the amendment is therefore requested.

Restriction Requirement

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Group I (claims 1 and 3) drawn to combinations of nucleic acids containing sequences selected from SEQ ID NOs:1-3, 5, 6, 8-10,12, 14, 15, 17, 18, 20, 22, 24, 26-29, 31, 33, 34, 36-39, 41-43, 45-47, 49, 51, 53, 55-58, 60, 62, 64, 66, 67, 69, 71, 72, 74-79, 81, 83-86, 88, 89, 91, 92, 94, 96, 97, 99, 100, 102-104, 106, 107, 109, 111, 112, 114, 116, 118, 119, 121, 123-126, 128, 130, 131-137, 139, 140, 142-151, 153-157, 159, 160, 162-165, 167-172, 174, 176, 177, 179-181, 183-187, 189-191, and 193.

Group II (claim 2) drawn to combinations of nucleic acids containing sequences selected from SEQ ID NOs:172, 174, 176, 177, 179-181, 183-187, 189-191, and 193.

Group III (claims 4-6) drawn to methods for detecting differential expression.

Group IV (claim 7) drawn to methods for identifying ligands.

Group V (claims 9-12) drawn to cDNAs, vectors, host cells and methods of producing proteins.

The Examiner stated that claim 8 is ungrouped because the claim does not depend from a method claim (as claim 8 recites) but from a composition. Thus, it is not clear which Group claim 8 ought to be in.

Claims 8 and 17 both depend from claims with higher numbers. Appropriate correction should be made in any response to this office action.

The Examiner stated that claims 1-7 are drawn to compositions reciting different combinations of individual nucleotide sequence, and that applicant is required to select one combination for examination. If the selected combination contains ten or fewer sequences, all of the sequences of the combination will be searched. If the selected combination contains more than ten sequences, the combination will be searched until one nucleotide sequence is found allowable. The identification of any allowable sequence(s) will cause all combinations containing the allowed sequence(s) to be allowed. See O.G. 68 (November 19, 1996).

The Examiner further stated that claims 9-12 are drawn to nucleotides, nucleotide constructs, and/or methods requiring the use of nucleotides or nucleotide constructs that contain more than one individual, independent, and distinct nucleotide sequence in alternative form. Applicant is required to select no more than one of the individual sequences for examination.

The Examiner also stated that claims 13-20 are drawn to more than one unrelated, independent and distinct polypeptide or methods requiring the use of more than one such polypeptide and that should applicants elect any one of Groups VI-VIII for examination, applicants are required to select one polypeptide or a set of methods that requires the use of only one polypeptide for examination on merits.

Applicants hereby elect, with traverse, to prosecute Group I which includes and is drawn to claims 1 and 3, and further elect the combination of SEQ ID NOs:24, 47, 81, 104, 114, 165 and 172. Applicants object to the restriction of claims to the various subcombinations of polynucleotide SEQ ID NOs: of the invention into separate examination Groups. Applicants submit that since the Examiner has agreed to search up to ten sequences relative to the examination of any one claimed combination of sequences, the selected combination recited by applicants above bears on the allowability of all combinations recited in claims 1-3 (Groups I and II) and their methods of use recited in claims 4-8 (Groups III and IV). As noted above, claim 8 has been amended to properly depend from method claim 7. Further, the selected combination bears on isolated cDNA sequences recited in claims 9-11, as amended, and their method of use as

recited in claim 12 (Group V). It is noted the Examiner considers that the examination of antibody composition of matter claims together with their methods of use (claims 17-20) may be accomplished without an undue burden of search and, therefore, applicants submit that the polynucleotide combination and composition of matter claims and their methods of use could likewise be examined together without undue burden. The examination of all of these claims may be accomplished by the search of the seven sequences in the combination selected by applicants. Applicants further submit that the combination of sequences was preselected by applicants based on BLAST analyses described in the specification at p. 26, line 23 through p. 27, line 3, at p. 32, lines 15-16, and summarized in Table 5. Thus, the Patent Office's burden of search is further reduced by applicant's optimizing the selection of potentially allowable sequences.

Applicants therefore request reconsideration of the Restriction Requirement and examination of claims 1-12 relative to the selected combination of SEQ ID NOs:24, 47, 81, 104, 114, 165 and 172.

In the event the Examiner maintains the Restriction Requirement, applicants reserve the right to request rejoinder of any polynucleotide composition of matter or combination claims withdrawn from examination that are subsequently found to contain allowable subject matter in accordance with O.G. 68 (November 19, 1996) which, as the Examiner has noted, states that:

Based on the finding of allowable sequences, claims limited to allowable sequences ... all combinations ... containing the allowable sequences and any patentably indistinct sequences will be rejoined and allowed.

Applicants further reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,

INCYTE CORPORATION

Date:

May 28, 2003

David G. Streeter

David G. Streeter, Ph.D.

Reg. No. 43,168

Direct Dial Telephone: (650) 845-5741

Customer No.: 27904
3160 Porter Drive
Palo Alto, California 94304
Phone: (650) 855-0555
Fax: (650) 849-8886